

REMARKS

Claims 1-22 remain in this application. Claims 1, 6, 9 and 16 have been amended. No new matter has been added.

In this Response, Applicant amends claims without prejudice and addresses the Examiner's rejections. Support for the amendments to the claims can be found throughout the application. Amendments to the claims are being made solely to expedite prosecution and do not constitute an acquiescence to any of the Examiner's rejections. Applicant's silence with regard to the Examiner's rejections of the dependent claims constitutes a recognition by the Applicant that the rejections are moot based on Applicant's remarks relative to the independent claim from which the dependent claims depend.

Claim Rejections Under 35 U.S.C. § 112 ¶2

Claims 6, 10, 19-22 and presumably claim 16 were rejected under 35 U.S.C. § 112 ¶2 as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regard as the invention. Applicant respectfully traverses this rejection. Applicant further submits that this rejection with respect to claims 6 and 16 is moot in view of the current amendment.

With respect to claims 10 and 19-22, the Examiner stated that "[i]t is not clear what are the structural elements set forth in claims 10, 19-22." Applicant respectfully traverses this rejection and further submits that there is no basis for a rejection of claims 10 and 19-22 under 35 U.S.C. § 112 ¶2. For the purposes of clarity and to expedite prosecution, Applicant presents a break down of claim 10 herein. Claim 10 reads, *inter alia*, a "towel of claim 9, wherein each of said plurality of pockets comprises:

- (a) a second piece of substantially flexible, durable, machine-washable textile-like material having
 - an interim access opening therein and
 - attached to said first face of said first piece of material,
 - thereby creating a pocket between the said first and second pieces of material which may be accessed by said interim access opening; and
- (b) a third piece of substantially flexible, durable, machine-washable material attached to said first face of said first piece of material and adapted to anchor said beach towel to other objects.

Similarly, claims 19-22 may be broken down into their respective elements.

However, Applicant respectfully submits that the presentation of the claims in normal paragraph form in no way affects the definiteness of such claims under 35 U.S.C. § 112 ¶2. Moreover, Applicant is not required to present such claims “with numerals from the drawings”, as was urged by the Examiner. Thus, for at least the above reasons, Applicant respectfully submits that the rejection of claims 10 and 19-22 under 35 U.S.C. § 112 ¶2 for indefiniteness should be withdrawn.

Claim Rejections Under 35 U.S.C. § 103(a)

Claims 1-8 and 19-22 were rejected under 35 U.S.C. § 103(a) as allegedly being obvious over U.S. Patent No. 6,192,536 to Connors (hereinafter “Connors”) in view of U.S. Patent No. 5,072,467 to Hunt (hereinafter “Hunt”) in further view of U.S. Patent No. 5,785,219 to Kraft (hereinafter “Kraft”). Applicant respectfully traverses this rejection. Applicant further submits that this rejection is moot in view of the current amendment.

Independent claim 1 is directed to a “self-storing pocketed beach towel comprising”, *inter alia*,

- (b) a plurality of pockets, each including at least one closure device, and each affixed to said first face of said towel;

- (c) at least one two-chambered compartment, including at least one closure device, and affixed to said first face of said towel, and adapted to store said towel when folded therein;
- (d) at least one fastening device, affixed to said first face of said towel, adapted for the fastening of said towel to other devices or objects; and
- (e) at least one adjustable carrying strap, to thereby provide a means of transporting said towel.

Claims 9-18 were rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Connors in view of Hunt. Applicant respectfully traverses this rejection. Applicant further submits that this rejection is moot in view of the current amendment.

Independent claim 9 is directed to a “self-storing beach towel adapted for securing to a support surface, comprising”, *inter alia*,

- (b) a plurality of pockets, each including at least one closure device, and each attached to said first face of said first piece of material at an edge thereof, for the receiving of material therein to anchor said first piece of material to the support surface;
- (c) at least one two-chambered pillow compartment, including at least one closure device and attached to said first face of said towel at one edge thereof, adapted for the storage of said beach towel and for the receiving of material therein to thereby serve as a pillow; and
- (d) at least one fastening device, attached to either said first face or said second face of said first piece of material at an edge thereof, adapted for fastening said beach towel to other objects or itself to create a tube-like or sleeping bag-like device.

Legal Standard for Obviousness

To reject claims in an application under Section 103, an examiner must establish a *prima facie* case of obviousness. Using the Supreme Court’s guidelines enunciated in *Graham v. John Deere*, 383 U.S. 1, 17 (1966), one determines “obviousness” as follows:

Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at

issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined.

In *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (2007), the Supreme Court reaffirmed the Graham test, and indicated that although it should not be rigidly applied, a useful test for determining obviousness is to consider whether there is a teaching, suggestion or motivation in the prior art that would lead one of ordinary skill in the art to combine known elements of the prior art to arrive at the claimed invention. Importantly, the Court emphasized that a patent examiner's analysis under Section 103 should be made explicit in order to facilitate review.

Thus, to establish a prima facie case of obviousness, the Examiner has an obligation to construe the scope of the prior art, identify the differences between the claims and the prior art, and determine the level of skill in the pertinent art at the time of the invention. The Examiner must then provide an explicit, cogent reason based on the foregoing why it would be obvious to modify the prior art to arrive at the claimed invention.

Applicant respectfully submits that the Examiner has failed to meet the burden required by *KSR* to establish a prima facie case of obviousness for the rejection under 35 U.S.C. § 103(a). The Examiner admits that Connors does not disclose "a double chambered compartment." *See* Office Action, p. 2. The Examiner supports his claim of obviousness based solely on the claim that "Hunt recognizes the desirability of dividing a pocket in a similar device." *See id.* Furthermore, the Examiner does not give any rationale for combining Connors and Hunt with Kraft. Applicant respectfully submits this basis is insufficient as a matter of law to support a rejection under 35 U.S.C. § 103(a), for the reasons set forth below.

Connors, Either Alone or in Combination With Hunt and Kraft, Does Not Disclose or Suggest All the Features of Independent Claim 1

Connors does not disclose or even suggest “at least one *two-chambered compartment*, including at least one closure device, and affixed to said first face of said towel, and *adapted to store* said towel when folded therein.” Indeed, the Examiner acknowledges that Connors fails to show the feature of “a double chambered compartment.” *See* Office Action, p. 2. The Examiner points to Hunt for the disclosure of “a double chambered compartment.” *See id.* However, the Examiner fails to point out, and Hunt does not disclose, a “two chambered compartment . . . *adapted to store* said towel when folded therein.” Rather, Hunt discloses “a beach towel which has envelopes attached thereto so that the envelopes can be employed to retain items brought to the beach by the beach goer, and pockets are formed under the envelopes so that sand can also be placed in the pockets to give the beach towel shape and/or hold it in place.” *See* Hunt, col. 1, lines 46-51. Thus the purpose of the double chambered pockets of Hunt is to have one chamber for the placement of personal items, while the other chamber may be filled with sand for weight and shape. Nowhere does Hunt disclose or suggest a “two chambered compartment . . . *adapted to store* said towel when folded therein.”

Similarly, Kraft does not disclose or suggest a “two chambered compartment . . . *adapted to store* said towel when folded therein.” Rather, Kraft discloses a single chambered compartment for the storage of the attached mat. *See* Kraft, col. 3, lines 26-29. Therefore, none of the cited prior art, alone or in combination, discloses or even suggests the feature of a “two chambered compartment . . . *adapted to store* said towel when folded therein.”

Moreover, independent claim 1, has the feature of a “fastening device, affixed to said first face of said towel, adapted for the fastening of said towel to other devices or objects.” As stated in the Specification, paragraph [0008], Connors does not disclose or even suggest such

a “fastening device . . . *adapted* for the fastening of said towel to other devices or objects.”

Furthermore, neither Hunt nor Kraft disclose or suggest the above quoted feature of independent claim 1. Therefore, none of the prior art, alone or in combination, discloses or even suggests each and every feature of independent claim 1. Thus, for at least the above reasons, Applicant respectfully submits that the rejection of independent claim 1 under 35 U.S.C. § 103(a) as unpatentable over Connors in view of Hunt and Kraft should be withdrawn. Claims 2-8 and 19-20 all depend from claim 1 and are patentable over the cited art for at least the same reasons discussed above.

Connors, Either Alone or in Combination With Hunt, Does Not Disclose or Suggest All the Features of Independent Claim 9

At least the same reasons that independent claim 1 is patentable over Connors, Hunt and Kraft apply to independent claim 9 in view of Connors and Hunt. Connors does not disclose or even suggest the “at least one two-chambered pillow compartment, including at least one closure device and attached to said first face of said towel at one edge thereof, *adapted for the storage* of said beach towel and for the receiving of material therein to thereby serve as a pillow.” Hunt does not cure this deficiency for at least the reasons discussed above with respect to claim 1. Therefore, none of the prior art, either alone or in combination, discloses or suggests each and every feature of independent claim 9.

Similarly to claim 1, claim 9 has the feature of a “fastening device . . . *adapted* for fastening said beach towel to other objects or itself to create a tube-like or sleeping bag-like device.” As stated above, neither Connors nor Hunt disclose or suggest this feature. Thus, for at least the above reasons, Applicant respectfully submits that the rejection of independent claim 9 under 35 U.S.C. § 103(a) as unpatentable over Connors in view of Hunt should be withdrawn.

Claims 10-18 and 21-22 all depend from claim 9 and are patentable over the cited art for at least the same reasons discussed above.

There Would Be No Motivation to Combine Connors with Hunt

None of the above cited references, alone or in combination, disclose or even suggest a towel that, *inter alia*, features a “two-chambered pillow compartment . . . *adapted for the storage* of said beach towel . . .” and a “fastening device . . . *adapted for fastening* said beach towel to other objects” Moreover, there existed, at the time of the invention, no motivation to combine the above cited references. The Examiner has stated there would be a motivation to combine Connors and Hunt “because Hunt recognizes the desirability of dividing a pocket in a similar device.” *See* Office Action, p. 2. Applicant respectfully submits that this rationale both fails to meet the standard set forth in *Graham*, and is incorrect because Hunt discloses that the purpose of having two-chambered compartments is for keeping sand ballast separate from the storage of personal items. *See* Hunt, col. 1, lines 46-51. This is clearly distinct from the feature of a “two-chambered pillow compartment . . . *adapted for the storage* of said beach towel.”

Furthermore, the Examiner has not set forth in detail what, if any, motivation existed at the time of the invention to combine either Connors or Hunt with Kraft. Thus, for at least the above reasons, the Examiner has failed to point out any motivation to combine and has failed to meet the standard set for in *Graham*.

Therefore, for at least the above reasons, Applicant respectfully submits that the rejection of independent claims 1 and 9 under 35 U.S.C. § 103(a) as unpatentable over Connors in view of Hunt and Kraft should be withdrawn. Furthermore, claims 2-8 and 10-22 all depend

from claims 1 or 9 and are patentable over the prior art for at least the same reasons discussed above.

CONCLUSION

Applicant does not believe that any additional fee is required in connection with the submission of this document. However, should any fee be required, or if any overpayment has been made, the Commissioner is hereby authorized to charge any fees, or credit any overpayments made, to Deposit Account 02-4377.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read 'Paul A. Ragusa', is written over a horizontal line.

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